The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY M. BLEIZEFFER, NATHAN D. CHURCH, KATHRYN W. DEVINE, VIRGINIA W. HUGHES, JR., BARBARA J. KILBURN and DAVID E. SHOUGH

Appeal No. 2003-0810
Application 09/058,170

ON BRIEF

Before THOMAS, JERRY SMITH, and BARRETT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-6, 11-18, 23-30, 35-42, 47 and 48. Claims 7-10, 19-22, 31-34 and 43-46 were indicated to contain allowable subject matter by the examiner.

In response to the appeal brief, the examiner has indicated that claims 3-6, 15-18, 27-30 and 39-42 now also contain allowable subject matter [answer, page 10]. Therefore, this appeal is now directed to the examiner's rejection of claims 1, 2, 11-14, 23-26, 35-38, 47 and 48.

The disclosed invention pertains to a method and apparatus for directing and assisting a user through procedures of a program required to perform various tasks on a complex software system. More particularly, the invention is used to lead a user to accomplish at least one of loading, installation, migration, fallback, remigration and update tasks of a program.

Representative claim 1 is reproduced as follows:

1. A method for leading a user through a program procedure on a computer to accomplish at least one of loading, installation, migration, fallback, remigration, and update tasks of a program, the method comprising the steps of:

a) displaying a window to the user providing information regarding parameters of the program;

b) transferring the user from the window to a parameter input window associated with one of the parameters selected by the user to be set or changed, wherein the user provides information in the parameter input window to set or change the value of the parameter,

the parameter input window being the only location where the parameters need to be set or changed.

The examiner relies on the following references:

Massaro et al. (Massaro)	5,535,321	July 09, 1996
Benton et al. (Benton)	5,675,756	Oct. 07, 1997
Paterson et al. (Paterson)	6,069,629	May 30, 2000 (filed Nov. 25, 1997)

Claims 1, 2, 11-14, 23-26, 35-38, 47 and 48 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Benton in view of Paterson with respect to claims 1, 11-13, 23-25, 35-37, 47 and 48, and Massaro is added to this combination with respect to claims 2, 14, 26 and 38.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

Appellants have indicated that for purposes of this appeal the claims will stand or fall together in two groups which correspond to the two rejections made by the examiner [brief, page 4]. Consistent with this indication appellants have made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejections against claims 1 and 2 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1,

17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d

1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

We consider first the rejection of representative claim 1 based on the teachings of Benton and Paterson. The examiner essentially finds that Benton teaches the invention of claim 1 except that Benton does not disclose the limitation of transferring the user from the window to a parameter input window associated with one of the parameters selected by the user to be set or changed, wherein the user provides information in the parameter input window to set or change values of the parameter, the parameter input window being the only location where the parameters need to be set or changed. The examiner cites Paterson as teaching this missing feature of claim 1. The examiner finds that it would have been obvious to the artisan to apply the teaching of Paterson to the Benton procedure [answer, pages 4-7].

Appellants argue that Benton fails to disclose any system or method which allows the user to modify, in any way, any parameters used by the program for its internal operation. Appellants assert that program parameters are different from data upon which the program operates. Appellants argue that both Benton and Paterson direct the user in changing data, not program parameters. Appellants argue that each of the tasks recited in claim 1 relates to updating and maintaining a program. Thus, appellants argue that Benton and Paterson teach how data used by a control or simulation program may be changed by a user, but neither reference teaches or suggests a method for a user changing program parameters that direct at least one of loading, installation, migration, fallback, remigration and update tasks that are related to installing and updating a program within the context of a particular operating system [brief, pages 4-9].

The examiner responds that Benton teaches that the graphic process editor 52 can be pulled into processor 50 to allow the user to create, modify and delete graphic display files which allows application database 100, 300 to be accessed and changed. The examiner also responds that the term parameter as used in claim 1 is broad enough to include the parameters changed by Paterson [answer, pages 12-16].

Appellants respond that the claimed invention operates on a program, not data, and in operating on the program, the invention recites a method for reviewing and changing parameters of the program. Appellants argue that both Benton and Paterson teach methods for changing data, not for changing the program [reply brief, pages 1-3].

We will sustain the examiner's rejection of claims 1, 11-13, 23-25, 35-37, 47 and 48. We do not agree with appellants' argument that the phrase "parameters of the program" as used in claim 1 requires the modification of parameters as used by the program for its internal operation or must relate to installing and updating a program within the context of a particular operating system. Claims are given their broadest reasonable interpretation during prosecution before the examiner because such claims can be appropriately amended by an applicant. The parameters of the program, as used in claim 1, can be broadly interpreted to include data in a control program as taught by Benton. We agree with the examiner that Benton clearly teaches a method in a control program for permitting the user to modify data parameters associated with the control program. Such a

teaching meets the recitation in claim 1 of "parameters of the program" when that phrase is given its broadest reasonable interpretation.

We now consider the rejection of representative claim 2 based on the teachings of Benton, Paterson and Massaro. The examiner cites Massaro as teaching the limitation recited in claim 2. The examiner finds that it would have been obvious to the artisan to add the teaching of Massaro to the Benton-Paterson combination discussed above [answer, pages 9-10].

Appellants' arguments with respect to this rejection essentially can be reduced to the argument that Massaro does not overcome the deficiencies in the basic combination of Benton and Paterson as argued with respect to claim 1 [brief, pages 9-10]. The examiner responds that Massaro teaches the two paths recited in claim 2, and that it would have been obvious to the artisan to provide an expert path and a non-expert path as taught by Massaro into the Benton-Paterson combination [answer, pages 16-17]. Appellants respond that Massaro does not teach or suggest a step-by-step process, but only a varying level of interaction with a program [reply brief, page 3].

We will sustain the examiner's rejection of claims 2, 14, 26 and 38. As discussed above, there are no deficiencies in the combination of Benton and Paterson. Claim 2 simply adds to claim 1 the recitation of two instruction paths, an expert path and a non-expert path. We agree with the examiner that Massaro teaches the option of providing two paths. Appellants' argument regarding a step-by-step process is not persuasive because there is nothing in claim 2 which limits the paths to a step-by-step process.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 2, 11-14, 23-26, 35-38, 47 and 48 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JAMES D. THOMAS
Administrative Patent Judge)
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JERRY SMITH)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
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